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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/248,382 02/10/99 MUKHERJEE

R U012104-2

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HM22/1002

EXAMINER

MOEZIE, F

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

10/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/248,382

Applicant(s)  
Mukherjee

Examiner  
F. T. Moezie

Group Art Unit  
1653



☒ Responsive to communication(s) filed on May 26, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) 5-31 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-31 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **STATUS OF CLAIMS**

Claims 1-4 are pending prosecution on their merits in this Office action.

In response to the Restriction Requirement, mailed 11/22/99, applicant elected Group I invention claims 1-4, with traverse. Because, there has been no reason(s) advanced for the traversal of the restriction requirement, the Requirement is deemed proper and made Final.

### **SPECIFICATION - OBJECTION**

The specification and claims contain abbreviations that are not clearly defined. The specification would have to define all of the abbreviated words at least in the first occurrence in the specification and in the independent claim(s).

### **REJECTION - 35 USC 112, FIRST AND SECOND PARAGRAPHS**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The use for the claimed compounds in treating a tumor in a patient is not enabled by the instant specification. There is no showing for the use of the claimed peptides in an art recognized model.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the expressions "Dxg" and "Aib" in the claims render the claims indefinite and unclear as to the claims' metes and bound. The terms are not art recognized and hence would have to be defined in the claim(s).

The examiner has noted that there are publications and/or related application(s) cited in the specification which are unavailable to the examiner at this time. If applicant considers these citations to be relevant to the complete examination of this application, applicant may submit a Form PTO-1449 along with the references cited therein for consideration by the Patent Office.

Claims are free of the prior art.

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**CONCLUSION**

No claims are allowed.

Any inquiry concerning this communication should be directed to F.T. Moezie at  
telephone number (703) 305-4508.

*F.T. Moezie*  
F.T. MOEZIE, Ph.D.  
PRIMARY EXAMINER  
ART UNIT ~~180~~  
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